

#50 / Response to Reply Brief 9/12/02 V. Hart

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of)
Rene Langhans) Examiner: C. Goodman
on ROTARY CUTTING UNIT) Group Art Unit: 3724
Serial No.: 08/883,685)
Filed on: June 27, 1997) (Atty. Docket No. 2821-193)

Hartford, Connecticut, August 21, 2002

Board Of Patent Appeals and Interferences
Washington, D.C. 20231

Appellant's Response To Examiner's Reply To The Board
(Paper No. 49) of August 8, 2002

SIR:

In response to the Examiner's Reply to the Board of Patent Appeals and Interferences, Paper No. 49, of August 8, 2002, Applicant respectfully submits the following remarks.

The Examiner has denied as untimely, entry of the supplemental evidence identified as Exhibits B and D to Applicant's Reply Brief dated May 21, 2001. The Examiner states that the Applicant has failed to show good and sufficient reasons why the evidence contained in the Exhibits B and D to the Reply Brief was not earlier submitted in response to the §112 first paragraph rejection first identified in the Office Action dated December 30, 1996.

Applicant respectfully submits that the rejection under 35 U.S.C. §112 is in part based on the Examiner's stated confusion as to the adjustment of the cutting gap between the two circular blades 2 and 4 of the claimed invention. In the Office Action, dated Dec. 30, 1996, the Examiner states, "Pg. 7, lines, 11 -21, the description of how the bush is displaced is confusing." (See Office Action, dated Dec. 30, 1996, ¶ 7, l. 14).

As disclosed in the original application, the cutting gap is established and adjusted by rotating the displacement bush 13 using the pin wrench 25 in a slot provided therefor. The Examiner's §112 rejection was first responded to in the Preliminary Amendment filed November 20, 1997 in response to the Office Action dated December 30, 1996. In the Preliminary Amendment, the Applicant addressed the rejection and attempted to clarify the Examiner's understanding of the disclosed configuration of the threaded displacement bush, the pin wrench for rotating the displacement bush and the slot for receiving the pin wrench. (Preliminary Amendment, filed November 20, 1997, pg. 8, ll. 14-20). Supplemental evidence defining a pin wrench and the operation thereof was not included in the Applicant's first response to the Examiner's §112 rejection because a pin wrench for rotating a threaded member and producing axial displacement is a simple and well known device in the mechanical arts. Evidence of such well know devices was not and is not deemed necessary. Stahelin v. Secher, 24 USPQ 2d, 1513, 1516 (B.P.A.I., 1992).

Subsequently, in the Office Action dated March 1, 1999, the Examiner repeated the same rejection, as follows: "Pg. 7, lines 11-21, the description of how the bush is displaced is confusing. Lines 14 -15 state that the pin wrench 25 is used to rotate the bush 13, yet it is not clear how this is accomplished." (Office Action, dated March 1, 1999, pg. 5, ll. 4-6).

In response to the Examiner's stated confusion, the Applicant filed an Amendment dated July 30, 1999, wherein the Applicant again attempted to clarify the Examiner's understanding of the cutting gap establishing and adjusting means, namely, the displacement bush, the pin wrench and the slot therefor. Included was new drawing (Fig. 5) to show further details of how the pin wrench is used to rotate the displacement bush. (See Amendment filed . pg. 7, ll. 5 -12). Figure 5 is the Exhibit D to Applicant's Reply Brief dated May 21, 2001 which the Examiner now states to be untimely filed, even though the figure was submitted in response to the Examiner's stated confusion.

In a Final Rejection, dated March 8, 2000, the Examiner again maintained the rejections under 35 U.S.C. §112 based on the operation of the pin wrench and refused to enter the proposed Figure 5 stating that the drawing included details not originally disclosed. (Office Action, dated March 8, 2000, pg. 4, ll. 3-9).

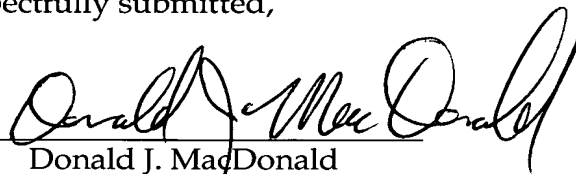
In a Supplement to the Appeal Brief, filed March 21, 2001, the Applicant first submitted copies of a Stanley Steam Car Handbook as well as a page from a parts catalog in a further attempt to communicate to the Examiner that pin wrenches and the use thereof were well known devices in the mechanical arts and did not require an elaborate disclosure. The Stanley Steam Car Handbook establishes the use of pin wrenches at least prior to 1924 when production of the Stanley Cars ceased. In any event, the Handbook and catalog page clearly establish the use of pin wrenches well prior to the date of the claimed invention such that one skilled in the art would quickly understand the use thereof in conjunction with the Applicant's disclosure. The Stanley Steam Car Handbook and the parts catalog page were attached as Exhibit B to the Appellant's Reply Brief dated May 21, 2001 which the Examiner has stated was untimely filed.

Applicant respectfully submits that the specification originally filed provides a disclosure sufficient for one skilled in the art to make and use the claimed invention, including the displacement bush, the pin wrench and the slot therefor. The supplemental evidence submitted was for the Examiner's benefit only, and, whether entered or not, the evidence is not needed to prove that the enablement requirement of §112 is met.

In view of the above, the Appellant maintains the position that pending claims 1-3, 5-8, 10-12 and 14-21 are described in the specification in such a way as to enable one skilled in the art to make and use the invention. Thus, Appellant respectfully requests that the Board reverse the Examiner's rejections under 35 U.S.C. § 112 first paragraph and allow the pending claims.

Respectfully submitted,

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